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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,783	12/24/2001	Michael Graupe	1016US	3968

7590

11/06/2002

Celera, An Applera Corporation Business  
180 Kimball Way  
South San Francisco, CA 94080

EXAMINER

SHIAO, REI-TSANG

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 11/06/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/035,783

Applicant(s)

GRAUPE ET AL.

Examiner

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Application received on 12/24, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This application claims benefit of the provisional application 60, 257,603 with a filing date 12/22/2000.
2. Claims 1-31 are pending in the application.

***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 8-9, 13-15, and 1-7, in part, are drawn to compounds or pharmaceutical compositions, classified in class 558, subclass various, depending on compounds election, wherein  $X_1$ ,  $R^3$ , and  $R^4$  substituents are non-heterocyclic moieties. If this group is elected, a further election of a single disclosed compounds of the group is also required.  
  
Generic claim 28, in part, which is related to pharmaceutical compositions, reading on the elected group can be prosecuted together with the election to the extend of the elected compounds.  
  
Generic claims 29-30, which are related to methods for use, can be prosecuted together with the election to the extend of the elected compounds upon election of a single disclosed disease associated with inhibition of Cathepsin S.

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Generic claim 31, wherein the process is applicable to making of elected compounds, can be prosecuted together with the election to the extend of the elected compounds.

- II. Claims 10-12,16-18, 19-21, 22-24, and 1-7, in part, are drawn to compounds or pharmaceutical compositions, classified in class 544-548, subclass various, depending on compounds election, wherein  $X_1$ ,  $R^3$ , and  $R^4$  substitutents are oxazol, morpholine, pyrrole, pyridine, oxadiazol, piperidine etc. (complete listings is not made). If this group is elected, a further election of a single disclosed compound of the group is also required.

Generic claim 28, in part, which is related to pharmaceutical compositions, reading on the elected group can be prosecuted together with the election to the extend of the elected compounds.

Generic claims 29-30, which are related to methods for use, can be prosecuted together with the election to the extend of the elected compounds upon election of a single disclosed disease associated with inhibition of Cathepsin S.

Generic claim 31, wherein the process is applicable to making of elected compounds, can be prosecuted together with the election to the extend of the elected compounds.

III. Claims 25-27, and 1-7, in part, are drawn to compounds or pharmaceutical compositions, classified in class 540-548, subclass various, depending on compounds election, wherein  $X_1$ ,  $R^3$ , and  $R^4$  substituents azepane, morpholine, or azetidine etc (complete listings is not made). If this group is elected, a further election of a single disclosed compound of the group is also required.

Generic claim 28, in part, which is related to pharmaceutical compositions, reading on the elected group can be prosecuted together with the election to the extend of the elected compounds.

Generic claims 29-30, which are related to methods for use, can be prosecuted together with the election to the extend of the elected compounds upon election of a single disclosed disease associated with inhibition of Cathepsin S.

Generic claim 31, wherein the process is applicable to making of elected compounds, can be prosecuted together with the election to the extend of the elected compounds.

IV Claims 1-7, in part, is receiving compounds not encompassed by group I or II or III, is drawn to compounds, classified in class 558, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species of the group is also required.

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Generic claim 28, in part, which is related to pharmaceutical compositions, reading on the elected group can be prosecuted together with the election to the extend of the elected compounds.

Generic claims 29-30, which are related to methods for use, can be prosecuted together with the election to the extend of the elected compounds upon election of a single disclosed disease associated with inhibition of Cathepsin S.

Generic claim 31, wherein the process is applicable to making of elected compounds, can be prosecuted together with the election to the extend of the elected compounds.

The inventions listed as Groups I-IV do not relate to a single general inventive concept because they lack the same or corresponding special technical features for the following reasons:

Inventions of Group I, II, III, and IV are independent and distinct because compounds of each group differ in elements, bonding arrangement and chemical property to such an extend that a reference anticipating compounds of any one group would not render another group obvious. The search for each group of compounds is not required for another group of compounds and is not coextensive of each other. Therefore separate search and examination must be required.

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Different search considerations are involved with each of the group listed above and would impose an undue burden on the Examiner and the Patent Office's resources if unrestricted.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different elements and the search required for Group I, for example, is not required for Group II or group III or group IV, restriction for examination purposes as indicated is proper.

4. Applicants are required to elect a single disclosed species from whichever group is ultimately elected.

Applicants are advised that the reply to this requirement to be complete must include an election of invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (703) 308-4002. The examiner can normally be reached on 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K McKane can be reached on (703) 308-4537. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Robert Shiao  
Patent Examiner  
Art Unit 1626

*R.S.*

*Joseph K. McKane*  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

October 31, 2002